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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/923.923

08/07/2001

Richard D. Martin

401-13U1

9008

570 7590 03/08/2007  
AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT

PAPER NUMBER

2154

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/08/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/923,923		MARTIN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Mohammad A. Siddiqi		2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/08/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. Claims 1-24 are presented for examination. Claims 13-24 are examined. Claims 1-12 have been cancelled.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 17-20 are non statutory, directed to software, per se, lacking storage on a medium which enables any underlying functionality to occur. Computer readable medium appears in the preamble. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is

insufficient written description for this limitation in the specification. The Computer readable medium is given broadest reasonable interpretation, which renders the Computer readable medium nonstatutory.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 13-24 are rejected under 35 U.S.C. 102(e) as being unpatentable as being anticipated by Pettersen et al. (US 6,826, 594) (hereinafter Pettersen).

6. As per claim 13, Pettersen teaches a method of constructing a web page that allows for syndication of digital assets, the method comprising:  
(a) constructing a web page (fig 2); and

(b) inserting into the web page script associated with at least one digital asset (fig 2, col 4, lines 11-28) that is desired to be part of a fully rendered web page (fig 2), wherein the script, when executed by a browser, requests the content of the digital asset from a remote site (fig 2, col 8, lines 6-30, the request including a uniform resource identifier (URI) of a web page and a unique identifier of the selected content (fig 2, col 8, lines 6-30).

7. As per claim 14, Pettersen teaches the script is JavaScript (fig 2, col 8, lines 6-30).

8. As per claim 15, Pettersen teaches a method of claim 13 wherein the selected content is an executable file (98, fig 2).

9. As per claim 16, Pettersen teaches a method of claim 13 wherein the script includes a subscriber identifier and a content identifier, which together, create the unique identifier of the selected content (col 27, line 15).

10. Claims 17 and 21 do not teach or define any new limitations above claim 13 and therefore are rejected for similar reasons.

11. Claims 18 and 22 do not teach or define any new limitations above claim 12 and therefore are rejected for similar reasons.

12. Claims 19 and 23 do not teach or define any new limitations above claim 15 and therefore are rejected for similar reasons.

13. Claims 20 and 24 do not teach or define any new limitations above claim 16 and therefore are rejected for similar reasons.

***Response to Arguments***

14. Applicant's arguments filed 01/18/2007 have been fully considered but they are not persuasive, therefore rejections to claims 13-24 is maintained.

15. 35 U.S.C. 101 rejection to claims 13 and 21 have been withdrawn.

16. 35 U.S.C. 112 rejection second paragraph to claim 21 has been withdrawn.

17. In response to applicant's Affidavit 1.131 submitted on 01/04/2007 examiner finds the following:

Reduction to Practice:

Applicant attempts to establish prior invention by showing RTP of the invention prior to the July 15, 2000, the effective filing date of Pettersen. What must be shown to have been reduced to practice is the CLAIMED invention.

In "FACTS AND DOCUMENTARY EVIDENCE" section of the affidavit applicant refers to EXHIBIT 1-3 submitted prior to the critical date which applicant alleges amounts to a reduction to practice of the invention. In particular EXHIBIT 1 (appendix A pages A1-A8) states: " @author Technology; @author ActivedataX.com; last changed 11/9/199", as corroborating evidence filed on 08/07/2000 along with provisional application (6022394), which substantiate that the undersigned inventor invented and "reduced to practice" the claimed invention of the instant patent application at least one day prior to July 15, 2000".

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad

terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). See MPEP 715.07.

Applicant has not explained how the exhibit supports the claimed invention. Therefore applicant has not made the necessary showing.

Furthermore, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

Applicant is relying on an Appendix A source code to show "Reduction to Practice". The Appendix A, at best, this document may only be able to establish conception of retrieving content from the Publisher server.

A source code, affiliate setup instruction and Syndicate Setup Instruction for Affiliate submitted create date (02/03/200) as exhibits 1-3 does not constitute an actual reduction to practice. Furthermore, only the



filing of a US patent application which complies with the disclosure requirement of 35 USC § 112 constitutes a constructive reduction to practice. A written description, no matter how complete, does not qualify as an actual reduction to practice.

Accordingly, applicant has not established prior invention. The rejection is maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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